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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/756,752	01/14/2004	Yoshihiro Seto	Q79385	1534
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SUITE 800				
WASHINGTON, DC 20037				
EXAMINER				
HYUN, PAUL SANG HWA				
ART UNIT		PAPER NUMBER		
1797				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/756,752

Applicant(s)

SETO ET AL.

Examiner

PAUL S. HYUN

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date 1/14/04
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

Figure 3 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. The Specification discloses that Figure 3 shows a conventional cartridge. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance. Pages 3-7 of the Specification describe Figure 3. The description of Figure 3 is in the "Description of the Related Art" of the Specification and the Specification refers to the drawing as "one example of a conventional analysis element cartridge". Therefore, the Figure should be labeled as prior art.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims **3 and 6-8** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 3 and 6 recite the limitation "the wall with no cutout". There is insufficient antecedent basis for this limitation in the claim. It is not inherent from the claim language that the claimed invention consists of 4 walls. Therefore, it is improper to assume that the claimed invention comprises "the wall with no cutout".

Claim 6 recites the limitation "wherein the dry analysis element is loaded in the cartridge while abutting the front end of the dry analysis element against the wall with no cutout". The limitation recites a method step, which confounds the scope of the claim. It is unclear whether the claimed invention actually comprises the dry analysis elements loaded in the cartridge.

Claims 7 and 8 recite the limitation "the left and right sides" and "the rear side". There is insufficient antecedent basis for this limitation in the claim. Although it is apparent that the claimed invention comprises left, right and rear sides, the claims have not positively established that cutouts are formed in these sides. It is suggested that claims specify that the cutouts are formed on the left, right and the rear sides before reciting limitations specifying the relative depths of the cutouts.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Crowley (US 6,663,100 B2).

Crowley discloses a magazine 200 for storing a stack of articles (see Fig. 3). The magazine comprises an open top, sides 206 and 208 comprising cutouts 210 that extend to the top edges of said sides, and front and rear sides 202 and 204 comprising cutouts 212 wherein the height of front and rear sides 202 and 204 are greater than the height of sides 206 and 208.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims **1, 2, 4, 5 and 7** are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's own disclosure of prior art in view of Crowley (US 6,663,100 B2).

According to the Specification of the instant application, Figure 3 shows a conventional cartridge that is well known in the art. The cartridge is designed to store and dispense dry analysis test strips. The cartridge comprises a housing chamber 31 comprising an element charging port that is defined by the opening at the top of the housing chamber, cutouts 32 and 33 formed in opposite walls of the housing chamber, a guide hole 35, and a take-out port through which the test strips are dispensed. The conventional cartridge differs from the claimed invention in that the conventional cartridge does not comprise cutouts on adjacent walls.

Crowley discloses a magazine 200 for storing a stack of articles (see Fig. 3). The magazine comprises an open top and sidewalls wherein each wall comprises cutouts. The reference discloses that the cutouts reduce friction when articles are loaded therein, and they allow the level and the condition of the stack to be easily viewed (see lines 23-28, col. 6). In light of the disclosure of Crowley, it would have been obvious to one of ordinary skill in the art to provide each wall of the conventional cartridge disclosed by Applicant with a cutout.

With respect to claim 7, since the front and the rear walls of the conventional cartridge comprise the take-out port and the guide hole, respectively, it would have been obvious to one of ordinary skill in the art not to form the cutouts as deep as the cutouts formed on the adjacent sidewalls.

Claims **3, 6 and 8** are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's own disclosure of prior art in view of Crowley as applied to claims 1, 2, 4, 5 and 7 above, and further in view of Cunningham (US 5,127,207).

Neither Crowley's cartridge nor the conventional cartridge disclosed by Applicant comprises walls that differ in height.

Cunningham discloses a tray that is designed to receive articles therein (see Fig. 3). The tray comprises four posts 36-39 wherein the height of posts 37 and 39 are greater than the height of opposing posts 36 and 38. The reference discloses that the height difference is designed to ease the loading of articles therein. The article being loaded initially hits the taller posts, which facilitates the alignment of the article as it is being loaded (see lines 19-25, col. 4). In light of the disclosure of Cunningham, it would have been obvious to one of ordinary skill in the art to differ the height of the walls of the modified conventional cartridge.

With respect to claim 8, since the front and the rear walls of the conventional cartridge comprise the take-out port and the guide hole, respectively, it would have been obvious to one of ordinary skill in the art not to form the cutouts as deep as the cutouts formed on the adjacent sidewalls.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL S. HYUN whose telephone number is (571)272-8559. The examiner can normally be reached on Monday-Friday 8AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jill Warden/
Supervisory Patent Examiner, Art Unit 1797

/Paul S Hyun/
Examiner, Art Unit 1797